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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/810,302   | 03/26/2004  | Nhut Nguyen          | 2003.10.010.NS0     | 8022             |
| 23990  | 7590        | 02/22/2008           | EXAMINER            |                  |
| DOCKET CLERK<br>P.O. DRAWER 800889<br>DALLAS, TX 75380 |             |                      | PHUNG, LUAT         |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 2616   |             |                      |                     |                  |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                 |               |
|------------------------------|-----------------|---------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)  |
|                              | 10/810,302      | NGUYEN ET AL. |
|                              | Examiner        | Art Unit      |
|                              | Luat Phung      | 2616          |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 March 2004.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

This action is responsive to the communication filed on December 13, 2007. Claims 1, 8, 9, 12 and 20 have been amended. Claims 1-24 are pending. Claims 1-24 are rejected.

### *Response to Amendment*

1. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The rejections and/or objections in this office action are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

2. On page 12, Applicant argues that:

The Examiner has failed to cite, and Applicant is unable to find, any reference within Zhang to the SIP server receiving a test call from the SIP client.

Examiner disagrees because:

Applicant's arguments have been considered but are moot in view of the new ground of rejection. Specifically, as recited in the rejection of claim 1, the call includes the functionality to test line conditions for noise and delay, etc., and is thus interpreted as a test call.

3. On page 12, Applicant further argues that:

In addition, the Examiner also cites the establishment of a SIP call between Dan and Shirley described in Zhang to show the establishment of a call connection for the test call between the originating terminal and a destination terminal. Office Action, page

4. However, the description of the SIP call establishment in Zhang relates to the establishment of a standard SIP call not to the establishment of a test call to test a voice path. See Zhang, pages 277-279. Zhang simply describes the use of SIP as an alternative to the H.323 standard for signaling in voice-over IP communication. Thus, Zhang describes the SIP protocol stack, the main features of SIP, and the architecture, messaging and operation of SIP. Zhang, Abstract. There is no mention in Zhang of a system for testing a voice path of a telecommunication device. (emphasis original)

Examiner disagrees because:

Applicant's arguments have been considered but are moot in view of the new ground of rejection. First, Applicant acknowledges that Zhang discloses establishment of a SIP call. Additionally, as recited in the rejection of claim 1, Osterhout discloses setting up a SIP call and testing the line conditions to ensure minimal requirements for a voice call, interpreted as testing the voice path.

4. On page 13, Applicant argues that:

The claimed invention does not provide for routing the test call such that the test call is not delivered through the packet-switched network.

Examiner disagrees because:

As a recap, as recited in the rejection of claim 1, the test call indeed is delivered "via a packet-switched network", as claimed in claim 1.

5. On page 13, Applicant further argues that:

Instead, a call connection for the test call is established between the originating terminal and a destination terminal via the allocated voice path and a packet-switched

network to test the allocated voice path. Thus, the call connection is established via the packet-switched network, not by being routed to the PSTN or looped back prior to being delivered through the packet-switched network.

Examiner disagrees because:

If Applicant argues that the test call must not be routed to the PSTN or looped back prior to being delivered through the packet-switched network, Examiner does not see such a limitation in the claims. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., call must not be routed to PSTN or looped back) are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As noted in the rejection of claim 1, Zhang inherently teaches routing the call "via a packet-switched network", as claimed in claim 1.

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1-18 and 20-24 are rejected under U.S.C. 103(a) as being unpatentable over Zhang (SIP-based VoIP network and its interworking with the PSTN, Electronics & Communication Engineering Journal, Dec. 2002) in view of Osterhout, et al (US 7,197,029).

Regarding claim 1, Zhang discloses for use in a telecommunication network, an apparatus for testing a telecommunication device comprising switching fabric including a plurality of voice paths, the apparatus comprising:

a SIP server (Fig. 8) configured to receive a test call from an originating terminal (SIP client in Fig. 8), establish a call connection for the test call between the originating

terminal and a destination terminal (call from Dan to Sherry on page 277, left column, lines 13-14).

Zhang does not explicitly disclose a test controller to prompt the telecommunication device to allocate one of the voice paths within the telecommunication device for the test call and establish a call connection via the allocated voice path and a packet-switched network to test the allocated voice path.

However in the SIP-PSTN call scenarios (page 279, right column, second paragraph, lines 3-4), Zhang teaches using the media gateway for media transcoding between the PSTN domain and IP domain (page 279, right column, second bullet paragraph), so that calls originating in the PSTN can reach IP phones and vice versa (page 280, right column, lines 2-4), interpreted as allocating a voice path to establish a call connection via the allocated voice path and a packet-switched network. Furthermore, Osterhout from the same or similar fields of endeavor discloses a test controller (host computer per abstract) configured to receive a test call (call made by user per abstract; host computer initiating call event, per abstract, interpreted as test controller receiving test call) from an originating terminal (SIP device per abstract) and establish a call connection via a packet-switched network (Internet per abstract) to test the allocated voice path (testing line conditions for noise and delay per abstract).

Thus it would have been obvious to the person of ordinary skill in the art at the time of the invention to combine Zhang's network with Osterhout's host computer by using the host computer, which has the ability to test line conditions for voice calls, as the test controller to establish a test call; specifically, initiating a call event, prompting

the media gateway to allocate a voice path, routing the call via the packet-switched network, and terminating to the destination terminal. If the applicants as persons of expert skill in the art have questions about this test setup, examiner as someone of ordinary skill in the art would be glad to avail himself to discuss how the Samsung softswitch and media gateway can be provisioned to facilitate this test bed. The motivation for using the voice path at the media gateway would have been to test the allocated voice path.

Regarding claim 2, Zhang further discloses wherein the voice paths comprise time division multiplexed (TDM) switched circuits (PCM encoded voice per page 279, right column, second bullet paragraph).

Regarding claim 3, Zhang further discloses wherein the originating terminal and the destination terminal are Session Initiation Protocol (SIP) phones (page 275, lines 11-12).

Regarding claim 4, Zhang further discloses wherein the test controller is configured to receive a signaling message for the test call from the originating terminal, the signaling message being addressed to an Internet Protocol (IP) address of the test controller (Fig. 5, line INVITE F1).

Regarding claim 5, Zhang further discloses wherein the signaling message is an INVITE message (Fig. 5, line INVITE F1).

Regarding claim 6, Zhang further discloses wherein the test controller is configured to send a signaling message to an IP address of the destination terminal (Fig. 5, line INVITE F8).

Regarding claim 7, Zhang further discloses wherein the test controller is configured to send a signaling message to a device controller within the telecommunication device (SIP message to the media gateway controller per page 281, left column, second paragraph), the device controller allocating the allocated voice path (page 279, right column, second bullet paragraph).

Regarding claim 8, Zhang further discloses wherein the allocated voice path provides a connection to a media gateway for converting between circuit-switched voice and packet-switched voice (page 279, right column, second bullet paragraph).

Claims 9-10 are substantial duplicates of claims 1-2, and are therefore rejected under the same reason set forth in the rejection of claims 1-2.

Claim 11 is a substantial duplicate of claim 8, and is therefore rejected under the same reason set forth in the rejection of claim 8.

Regarding claim 12, Zhang further discloses the telecommunications system as set forth in claim 9, wherein the telecommunication device comprises: switching fabric (media gateway and voice stream in Fig. 6) including a plurality of voice circuits for switching voice calls (page 279, right column, second bullet paragraph); and

a controller (media gateway controller in Fig. 6) operable to receive a signaling message (SIP in Figure 6) from the test controller to establish the call connection for the test call through the packet-switched network, the controller being further operable to allocate one of the voice circuits for the test call to test the allocated voice circuit (page 279, right column, last paragraph to page 280, left column, first paragraph).

Claims 13-17 are substantial duplicates of claims 3-7, and are therefore rejected under the same reason set forth in the rejection of claims 3-7.

Regarding claim 18, Zhang further discloses wherein the telecommunication device is a switch (gateway per Fig. 6).

Claims 20, 21 and 22-24 are method claims corresponding to apparatus claims 1, 8 and 4-6, respectively, and are therefore rejected under the same reason set forth in the rejection of claims 1, 8 and 4-6, respectively.

2. Claims 19 is rejected under U.S.C. 103(a) as being unpatentable over Zhang in view of Dorenbosch, et al (US Pub 2002/0114317).

Regarding claim 19, Zhang discloses all of the subject matter as previously recited in this office action except wherein the switch is a mobile switching center. Dorenbosch from the same or similar fields of endeavor discloses system comprising an MSC (Fig. 3, element 302) communicating with a SIP peer/server (Fig. 3, element 206). Thus it would have been obvious to the person of ordinary skill in the art at the time of the invention to combine the network of Zhang with the MSC of Dorenbosch by replacing the media gateway controller with the MSC. The motivation for the combination would have been to support testing a voice path on a wireless system.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form 892).

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

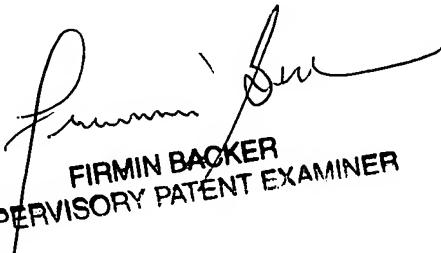
11. Examiner's Note: Examiner has cited particular paragraphs, columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and, also to verify and ascertain the metes and bounds of the Claimed invention.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luat Phung whose telephone number is 571-270-3126. The examiner can normally be reached on M-Th 7:30 AM - 5:00 PM, F 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LP

  
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